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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,205	09/18/2003	Wolfgang Stampfer	HL/95-22634/CIP	8858
324	7590	11/29/2007	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			PAK, YONG D	
ART UNIT		PAPER NUMBER		1652
MAIL DATE		DELIVERY MODE		11/29/2007 PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/666,205	STAMPFER ET AL.
Examiner	Art Unit	
Yong D. Pak	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 24 September 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 45 and 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 45 and 49 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

This application is a CIP of PCT/EP03/02439.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 24, 2007, amending claims 45 and 49 and canceling claims 46-48 and 50, has been entered.

Claims 45 and 49 are pending and are under consideration.

***Response to Arguments/Amendments***

Applicant's amendment and arguments filed on September 24, 2007, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied, as described below.

***Specification***

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code, page 43 for example. Applicant is required to

delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

***Claim Objections***

In view of the amendment of claims 45 and 49 and the cancellation of claim 47, the objections to claims 45, 47 and 49 have been **withdrawn**.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

In view of the cancellation of claim 47, the rejection of claim 47 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, has been **withdrawn**.

In view of the cancellation of claim 47, the rejection of claim 47 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, has been **withdrawn**.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 45 and 49 are rejected under 35 U.S.C. 102(a) as being anticipated by Stampfer et al.

Claims 45 and 49 are drawn to an alcohol dehydrogenase comprising the amino acid sequence of SEQ ID NO:48.

Stampfer et al. (form PTO-1449) discloses an isolated alcohol dehydrogenase obtained from *Rhodococcus ruber* DSM 44541 (page 1014-1015). The specification of the instant invention on page 49 teaches that *Rhodococcus ruber* DSM 44541 and *Rhodococcus ruber* DSM 14855 are the same microorganism. Further, both the alcohol dehydrogenase of Stampfer et al. and the alcohol dehydrogenase of SEQ ID NO:48 of the instant invention use 2-propanol/acetone as co-substrates in oxidizing 2-octanol (Scheme 1, Table 2 and Figures 1 and 2 of Stampfer et al. and Tables 7 and 8 of the instant specification on pages 39-40). Therefore, Examiner takes the position that the alcohol dehydrogenase of Stampfer et al. is 100% identical to the alcohol dehydrogenase of SEQ ID NO:48 of the instant invention. Thus, the alcohol dehydrogenase of Stampfer et al. inherently possesses the same material structure characteristics as the alcohol dehydrogenase of claims 45 and 49 since both alcohol dehydrogenases are obtained from the same source and have the same function. Since the Office does not have facilities for examining and comparing applicant's alcohol dehydrogenase with the alcohol dehydrogenase of the prior art, the burden is on the applicant to show a novel or unobvious difference between the claimed product and the product of the prior art (i.e., that the alcohol dehydrogenase of the prior art does not possess the same material structure and functional characteristics of the claimed

alcohol dehydrogenase). See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald et al.*, 205 USPQ 594. Therefore, the reference of Stampfer et al. anticipates claims 45 and 49.

In response to the previous Office Action, applicants have traversed the above rejection.

Applicants argue that the claims are not anticipated by Stampfer et al. because (1) since Stampfer et al. does not disclose an amino acid sequence of the alcohol dehydrogenase, Stampfer et al. does not reveal the exact same isolated polypeptide recited in claims 45 and 49 and (2) Stampfer et al. does not disclose variants of the isolated polypeptide having alcohol dehydrogenase activity having up to 5% amino acid replacements. Examiner respectfully disagrees.

(1) The amino acid sequence of an enzyme is an inherent property of the enzyme. Since the alcohol dehydrogenase of Stampfer et al. and the alcohol dehydrogenase of SEQ ID NO:48 of the instant invention are obtained from the same source and have the same function, the alcohol dehydrogenase of Stampfer et al. inherently possesses the same material structure and functional characteristics as the alcohol dehydrogenase of claims 45 and 49. Since the Office does not have facilities for examining and comparing applicant's alcohol dehydrogenase with the alcohol dehydrogenase of the prior art, the burden is on the applicant to show a novel or unobvious difference between the claimed product and the product of the prior art (i.e., that the alcohol dehydrogenase of the prior art does not possess the same material structure and functional characteristics of the claimed alcohol dehydrogenase). See *In*

*re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Figzgerald et al.*, 205 USPQ 594. Further, MPEP 2112 states that "Once a reference teaching product appearing to be substantially identical is made the basis of a rejection, and the Examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference". Applicants have not shown an unobvious difference between the enzyme of Stampfer et al. and the instant invention.

(2) Claim 45 is drawn to a polypeptide comprising the amino acid sequence of SEQ ID NO:48 or a polypeptide comprising a variant of the amino acid sequence of SEQ ID NO:48. Stampfer et al. does not have to disclose a polypeptide comprising a variant of the amino acid sequence of SEQ ID NO:48 in order to anticipate claim 45.

Hence the rejection is **maintained**.

### **Conclusion**

Claims 45 and 49 are rejected.

No claim is allowed.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 571-272-0935. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



Yong D. Pak  
Patent Examiner 1652